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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/884,778	06/30/97	NAKAMURA K	80A2601-CIP

IM61/0520

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EXAMINER
MARCHESCHI, M

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 05/20/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/884,778	Applicant(s) Nakamura
	Examiner Michael Marcheschi	Group Art Unit 1755

☐ Responsive to communication(s) filed on ____________.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1 and 2* is/are pending in the application.

Of the above, claim(s) ____________ is/are withdrawn from consideration.

☐ Claim(s) ____________ is/are allowed.

☒ Claim(s) *1 and 2* is/are rejected.

☐ Claim(s) ____________ is/are objected to.

☐ Claims ____________ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on ____________ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on ____________ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) ____________.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ____________.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). ________

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The use of the trademark "BCOPLA" (page 7, line 7) has been noted in this application. It should be capitalized wherever is appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The disclosure is objected to because of the following informalities:

On page 5, line 4, "BDT'S" should be "**BDP'S**".

Appropriate correction is required.

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is indefinite as to the phrase "size of 2 mm pass" since the examiner is unclear as to what this encompasses. Is applicant claiming that the material passes through a 2 mm sieve (size less than 2 mm)?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokiwa et al. alone or in view of Moriya et al.

Tokiwa et al. teach in column 2, lines 56-58 and claims 1-3, a biodegradable molding material comprising 30-70 volume % of a biodegradable resin (aliphatic polyesters), 1-70 volume % of a naturally occurring high molecular weight substance and 0-45 volume % of a filler. It is shown that the naturally occurring high molecular weight substance can be pulp powder or powdery cellulose.

Moriya et al. teach in column 5, lines 10-12 that powder paper obtained by pulverizing paper or pulp is a well known cellulose source.

It is the examiners position that "pulp powder or powdery cellulose" encompasses and therefore makes obvious paper powder in the absence of any evidence showing the contrary. In the alternative, the use of paper powder would have been obvious as the powdery cellulose source according to Tokiwa et al. because paper powder is a well known cellulose material (see Moriya et al.) With respect to the way the paper is powdered, this limitation is considered obvious because this is a well known conventional way to make powdered paper (again see Moriya et al.). In the alternative, applicant uses process limitations to define the product and "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, the desired particle size of the paper is a

function of the application and mere recitation of that size does not represent a patentable distinction over this reference to one of ordinary skill in the art, lacking evidence to the contrary.

In view of this, it is the examiners position that Tokiwa et al. alone or in view of Moriya et al. teach a reasonably similar molding material comprising the claimed components and ranges thereof which overlap the claimed ranges and therefore the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of all the claims.

"A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

The additional references on the 892 have been cited as art of interest since they are cumulative to or less than the art relied upon in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi
Art unit 1755
5/15/98

MICHAEL MARCHESCHI
PRIMARY EXAMINER